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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,536	04/11/2006	Thomas Busse	851.0005.U1(US)	8934
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EXAMINER NGUYEN, QUYNH H				
ART UNIT		PAPER NUMBER		
2614				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,536

Applicant(s)

BUSSE, THOMAS

Examiner

QUYNH H. NGUYEN

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claims 14-16 claim the non-statutory subject matter of a computer program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed computer program is not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention falls outside of the statutory categories. Claim 6 is drawn to steps performed purely by software (i.e., see page 1, lines 7-8) and software per se is neither a "product" nor a "process" in a statutory sense. The aforementioned intrinsic evidence in the specification suggests that the full scope of the claimed encompasses nothing more than software and is therefore non-statutory for that reason. Furthermore, a practical application exists if the *result* of the claimed invention is "useful, concrete and tangible".

Claims 1-5 and 7 recite "A method for offering by a second device using a first device" that is performed by software (for example, page 1, lines 7-8). In order for a method to be considered a "process" under 101, a claimed process must either (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876)). If neither of these requirements is met by the claims, the method is not a patent eligible process under 101 and is non-statutory subject matter, as is the case of Claim 1. Thus, to qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, because claims 8-13 are single means claims, where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph. Claim 6 recites "an other device". It is unclear as what is an other device? Is an other device a host?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6-11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Benq Corporation (AWL-100 User Manual) page 13, hereinafter Benq Corporation.

Claims 1, 6-11, and 14-16 are very broad that any applications would read on the claims. For example, when one make a request from his / her computer to search for nearby wireless network, a list of neighboring network names or user-friendly names will displayed on his/her computer. Another example is Benq Corporation user manual page 13, as to claim 1, Benq Corporation teaches: the first device makes a service search request (*a user using his/her laptop computer makes a scan request for available Access Points in his/her neighborhood*); the second device (*another access point of another user*) receives search request and sends at least an attribute identifying a user-friendly name (SSID); and the first device receives the attribute, obtains a user friendly name from the received attribute and displays the user-friendly name (page 13 - *display SSID at user laptop computer*). Similarly, this would read on claims 6-11 and 14-16.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by admitted prior art Flemming et al. (U.S. 2003/0158952).

As to claims 1 and 7, Flemming teaches a method for discovering the service offered by a second device (Fig.1 , 120) using a first device (Fig.1 , 110) comprising: the first device (Fig.1 , 110) makes a service search request ([0019]); the second device (Fig.1 , 120) receives the service search request and sends at least a first attribute identifying a user-friendly name ([0019] - [0021]); and the first device receives the first

attribute, obtains a user friendly name from the received first attribute ([0020] - [0021]; page 2, claim 1); and user can select a service from the services available for connection ([0022]), hence it is inherent that user friendly service names are displayed.

As to claim 2, Flemming teaches the first device is an SDP client (Fig. 1, 110) and the second device is and SDP server (Fig. 1, 120).

As to claim 3, Flemming teaches the first device is an Application Host and the second device is an Application Client ([0017]).

As to claim 4, Flemming teaches the service search request is a request relating to a first service record stored in a database of the second device (*database where service records stored in device 120 that not shown*) ([0019] - [0020]).

As to claim 5, Flemming teaches the second device sends the attributes of the requested first service record (*ServiceRecord1*) ([0020] - [0021]; page 2, claim 1).

As to claim 6, Flemming teaches a device operable as a host of an interactive application comprising: means for sending a message to an other device (Fig. 1, 120) to determine whether that other device offers a service ([0017]; [0019]); and means for receiving a plurality of attributes in response to the message from the other device and determining a user friendly name (*Service Name*) identifying the other device from the received plurality of attributes ([0021] - [0022]).

As to claims 8 and 10, Flemming teaches means for creating a service record, associated with the interactive application that includes a friendly user definable name identifying the device or its user (Fig. 2, [0020] - *it is inherent that service records are created/generated either by an operator or processor in the device*).

As to claims 9 and 11, Flemming teaches the service record comprises attribute identifying a service class (Fig. 2, Service Class).

As to claims 12 and 13, Flemming teaches a device operable to send/receive a user-friendly device name during service discovery protocol ([0017]; [0019]; [0021] - [0022]).

As to claim 14, Flemming teaches a computer program when loaded into a processor enables an interactive multi-user application ([0023]) comprising: means for defining a first service record ([0020] - *ServiceRecord1*); means for defining a first attribute ([0020] - *Service Class, Service Name*); means operable to include a user-friendly device name as a first attribute of a first service record for storage in a database ([0020]; [0024]).

Claim 15 is rejected for the same reasons as discussed above with respect to claim 14. Furthermore, Flemming teaches means for operable to obtain a user-friendly device name from a first attribute of a first service record received from another device ([0022]).

Claim 16 is rejected for the same reasons as discussed above with respect to claims 14 and 15.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quynh H Nguyen/
Primary Examiner, Art Unit 2614